

## **REMARKS**

Reconsideration of this application is respectfully requested in view of the above amendments and the remarks contained herein.

## **STATUS OF CLAIMS**

Claims 1-26 are pending in this application. With respect to the amendment to claim 2 the Office's attention is directed to paragraph [0061] of the originally filed specification.

## **WITHDRAWN REJECTIONS**

Applicants note with appreciation the withdrawal of the rejections under 35 U.S.C. § 103(a) over Ainai in view of Nishiyama et al.

## **ANTICIPATION REJECTION**

At pages 2-4 of the Office Action dated May 20, 2009, the Office has rejected claims 1-3, 5-6, 8-11, 13-14 and 16-20 under 35 USC § 102(e) as being unpatentable over U.S. Patent No. 6,424,429 (Takahashi et al.). Applicants respectfully traverse this rejection for the reasons given below.

Applicants respectfully submit that Takahashi et al. does not anticipate the rejected claims because Takahashi et al., fails to disclose every feature of the claimed invention as recited in the claims. For example, Takahashi et al. fails to disclose a reception portion for receiving the image data which is transferred by the transfer portion and stored in the image memory of the memory-incorporating apparatus in accordance with the memory recall signal.

Takahashi et al. discloses a file system where document data processed by a copying machine is backed up in a server having essentially infinite memory, so that document data can be reused. Also, Takahashi et al. discloses that the document data, which is accumulated in the infinite memory server, is displayed in thumbnail images when the document data is reused, and that the particular document data to be reviewed is selected from the thumbnail images and sent to the copying machine. Further, Takahashi et al. discloses that a job recall button is provided on an operation display panel.

The examiner has stated that Takahashi et al. discloses a job recall button. However, Takahashi et al. does not disclose what kind of processing is performed by pressing the job recall button.

Moreover, Takahashi et al. fails to disclose a reception portion for receiving the image data which is transferred by the transfer portion and stored in the image memory of the memory-incorporating apparatus in accordance with the memory recall signal, as recited in Applicants' claims.

In the case of Takahashi et al., it is necessary to give a transfer instruction through the server when the data is reused. In other words, it is impossible to give the transfer instruction from the copying machine in Takahashi et al. In the present invention, on the other hand, pressing the memory recall key, which is provided in the image forming apparatus itself, makes it possible to easily use the image data transferred by the transfer portion and stored in the image memory of the memory-incorporating apparatus. Thus, the present invention is clearly different in structure from the invention of Takahashi et al.

The present invention provided with the above-stated feature has an advantageous effect in that the image data, which is transferred by the transfer

portion and stored in the image memory of the memory incorporating apparatus, can be easily output by pressing the memory recall key provided in the image forming apparatus itself. There is no need to give a transfer instruction through a server. Takahashi et al. does not disclose such a structure.

It is well accepted that, in order for a reference to anticipate a claim, that reference must disclose every element recited in the claim and arranged as recited in the claims. See *Net MoneyIN Inc. v. VeriSign Inc.*, 545 F.3d 1359, 88 USPQ2d 1751 (Fed. Cir. 2008); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *In re Arkley*, 455 F.2d 586, 172 USPQ 524 (CCPA 1972). Since Takahashi et al. fails to satisfy this standard for the reasons given above, Applicants respectfully submit that it does not anticipate Applicants' claims, and that this rejection should be withdrawn.

#### OBVIOUSNESS REJECTIONS

On pages 5-6 of the Office action dated May 20, 2009, the Office has rejected claims 4, 7, 12 and 15 under 35 U.S.C. § 103(a) as obvious over Takahashi et al. in view of U.S. Patent No. 6,067,168 (Nishiyama et al.). Applicants respectfully traverse this rejection for the reasons given below.

Applicants submit that Takahashi et al. does not disclose at least one of the elements recited in Applicants' claims for the reasons given above. Claims 4, 7, 12, and 15 also include this missing element. Moreover, Nishiyama et al. does not cure the deficiencies of Takahashi et al. in this regard. Accordingly, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness and that this rejection should therefore be withdrawn.

Since the Office has failed to establish a *prima facie* case of obviousness, Applicants submit that this rejection should be withdrawn.

On pages 6-8 of the Office action dated May 20, 2009, the Office has rejected claims 21-26 under 35 U.S.C. § 103(a) as obvious over Takahashi et al. in view of U.S. Patent No. 5,663,800 (Ainai et al.). Applicants respectfully traverse this rejection for the reasons given below.

Applicants submit that Takahashi et al. does not disclose at least one of the elements recited in Applicants' claims for the reasons given above. Claims 21-26 also include this missing element. Moreover, Ainai et al. does not cure the deficiencies of Takahashi et al. in this regard. Accordingly, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness and that this rejection should therefore be withdrawn.

For these reasons, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness, and that this rejection should be withdrawn.

For these reasons, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness, and that this rejection should be withdrawn.

## CONCLUSION

Applicants submit that this application is in condition for immediate allowance, and an early notification to that effect is respectfully requested. If the Examiner has any questions about this application, or believes that any issues remain to be resolved, the Examiner is respectfully requested to contact the undersigned to arrange for a personal or telephonic interview to resolve these issues prior to the issuance of another Office action.


The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: October 20, 2009

By:

  
Bruce D. Gray  
Registration No. 35799

**Customer No. 21839**  
(703) 836-6620